



AP
#

Docket 81803F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

William C. Tate

METHOD SYSTEM AND
SOFTWARE FOR ORDERING
GOODS AND/OR SERVICES
OVER A
COMMUNICATION NETWORK

Serial No. 09/709,143

Filed November 10, 2000

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Frank Pincelli/phw
Telephone: 585-588-2728
Facsimile: 585-477-4646
Enclosures

Group Art Unit: 3625

Examiner: Maria Teresa T. Thein

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Paula West
Paula West

7-26-04
Date

Respectfully submitted,

Frank Pincelli
Attorney for Appellants

Registration No. 27,370



ITW AF

Docket 81803F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

William C. Tate

METHOD SYSTEM AND
SOFTWARE FOR ORDERING
GOODS AND/OR SERVICES
OVER A
COMMUNICATION NETWORK

Serial No. 09/709,143

Filed 10 November 2000

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 3625

Examiner: Maria Teresa T. Thein

I hereby certify that this correspondence is being
deposited today with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner For Patents, P.O. Box 1450, Alexandria,
VA 22313-1450.

Paula West
Paula West

7.26.04
Date

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

07/30/2004 MBELETE1 00000033 050225 09709143

01 FC:1402 330.00 DA



Table Of Contents

<u>Table Of Contents</u>	i
<u>Real Party In Interest</u>	1
<u>Related Appeals And Interferences</u>	1
<u>Status Of The Claims</u>	1
<u>Status Of Amendments</u>	1
<u>Summary Of The Invention</u>	1
<u>Issues For Review By The Board</u>	2
<u>Grouping Of Claims</u>	2
<u>Arguments</u>	2
<u>The Rejection</u>	2
<u>Summary</u>	4
<u>Conclusion</u>	4
<u>Appendix I - Claims on Appeal</u>	5



APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-36 which was contained in the Office Action mailed March 9, 2004.

A timely Notice of Appeal was filed June 1, 2004.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-36 have been rejected and are appealed

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

All of the amendments have been entered and the claims stand as indicated in Appendix I.

Summary Of The Invention

The present invention is directed to an improved method, software, product and system whereby an e-mail having very large files may be forwarded in an efficient manner to third party recipients. In particular, the present invention is directed to an e-mail that has a static section 42 (see Fig. 3a) for containing static text and/or graphics, and a dynamic section 42a-42b for containing dynamic data. The static sections 44a are viewed immediately upon opening of the e-mail at the receiving site. However, the dynamic data is forwarded to the receiving site only upon opening of the e-mail at the receiving site.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 14-16, 18-26 and 28-29 are unpatentable under 35 USC § 102(e) as being anticipated by U.S. Patent 6,321,231 to Jebens.
2. Whether claims 1-13, 17, 27 and 30-36 are unpatentable under 35 USC § 103(a) over U.S. Patent 6,321,231 to Jebens in view of U.S. Patent 6,388,732 to Williams et al.

Grouping Of Claims

Group I: Claims 1-36

Arguments

The Rejection

Group I – Claims 1-36

- A. The Examiner, in the Official Action dated March 9, 2004, rejected claims 14-16, 18-26, and 28-29 under 35 USC § 102(e) as being anticipated by Jebens.

The present invention is directed to sending e-mails that may be very large. The transmission of very large files may result in long transmission times and may discourage individuals from forwarding to other individuals.

The present invention provides a method of forwarding e-mails whereby e-mail includes both static and dynamic sections. The static section is displayed immediately upon opening of the e-mail, however the dynamic section is retrieved only upon opening the e-mail. Thus, the information with regard to the dynamic sections are only retrieved once the e-mail has been opened. Independent claims 1, 14, 27, 28, 29 and 30 all include the limitation that the e-mail has a static section for containing static text and/or graphic, and a dynamic section for containing dynamic data in that the dynamic data is automatically forwarded to the receiving site only upon opening the e-mail at the receiving site. All the remaining claims depend at least ultimately upon the foregoing independent claims.

The Examiner has relied upon Jebens for disclosing the e-mail having a static section and a dynamic section. The Examiner cites column 21,

lines 63-67 and Figures 10F, 10G and 10I for illustrating the dynamic data to be automatically forwarded. However, examination of these passages and figures do not support this. At column 1, lines 63-67, there is merely disclosed a custom e-mail form 820 in which user fills out and designate who the recipient of an e-mail shall be. The form also provides for providing a short description and instructions for the receiving of the e-mail. This does not discuss or suggest the providing of both static and dynamic sections as taught and claimed by Applicants. The figures relied upon by the Examiner do not teach or suggest providing both static and dynamic sections. The Examiner, in the advisory action dated June 9, 2004, stated:

“Examiner notes Jebens discloses ‘e-mail is sent to a recipient that includes both a static and dynamic portions such than oly [sic] upon opening the static portion will then the dynamic portion be automatically sent to the recipient’ In Figure 10I, the read order transmission block 860 via mail client includes sections for ‘Description’ and ‘Instructions’ which are static and another section for ‘view attachment’ which is dynamic”.

Applicant respectfully submit that the Examiner’s statement is not consistent with the specification and the designated figure. In particular, column 23, lines 9-19 provide a clear description of Figure 10I. This section states:

“Turning to FIG. 10I, the destination user/supplier 16 receives the fax or e-mail notification of the job order transmission (block 860) from the mail server 26 of the host site 10. As shown in FIG. 10I, the hot-folding software at the jobber site 16 will have preferably already received the job order (block 862); decompressed the job order (block 864); and stored the job order to the appropriate incoming folder (block 866). The jobber 16 can then access the job order by clicking on the appropriate incoming folder icon. The e-mail description and instruction form can be stored on the supplier’s local computer or printed out as desired.”

As can be seen, the hot-folding software is provided at the jobber site 16 (see line 12). The jobber site 16 is the recipient of the e-mail, thus the hot-folding software is present at the jobber site. As further set forth in that paragraph, the jobber 16 can access the job order by clicking on the appropriate incoming folder icon. Thus, the e-mail is already at the recipient site. This is contrary to what is taught and claimed by Applicant. There is no teaching or suggestion that an e-mail is sent to a recipient that includes both static and dynamic portions such that only upon opening the e-mail will the dynamic portion then be sent to the recipient. Upon initial opening of the e-mail, the static portion

is immediately viewable which gives time for the dynamic section to be forwarded to the user.

The Williams reference (U.S. 6, 388,732) cited by the Examiner is of little relevance to the present invention. It is disclosed herein there is forwarded to the customer low resolution digital images of images that have been stored from the film. See Fig. 1 and column 1, lines 45-60, and column 2 line 60 through column 3, line 17. There is nothing to teach or suggest the providing of a single e-mail having both static and dynamic sections as taught and claimed by Applicant, and therefore believe this patent reference is of little relevance to the claimed invention.

The remaining claims depend at least ultimately upon the independent claims previously discussed. Accordingly, these dependent claims are patentably distinct for the same reasons. The various other portions of Jebens cited by the Examiner and the Williams reference do not teach or suggest the providing of an e-mail having both static and dynamic sections as taught and claimed by Applicant.


Summary

In summary Applicant respectfully submit that the present invention is patentable over the cited art.

Conclusion

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims .

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written over a horizontal line.

Attorney for Appellants
Registration No. 27,370

Frank Pincelli/phw
Telephone: 585-588-2728
Facsimile: 585-477-4646
Enclosures

Appendix I - Claims on Appeal

1. (original) A method for ordering goods and/or services with respect to digital images over a communication network, comprising:

providing a server of a first party for sending e-mail to a receiving site of a customer over said communication network, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said dynamic data comprising at least digital data files containing digital images.
2. (original) A method according to claim 1 wherein said server having a low-resolution digital image file of at least one said digital image, wherein said dynamic data comprises said low-resolution digital image file.
3. (original) A method according to claim 1 wherein said static text and/or graphics comprises an order form for placement of an order for goods and/or services with respect to said image.
4. (original) A method according to claim 1 wherein said static text and/or graphics includes at least one location for receiving said digital image upon opening of said e-mail.

5. (original) A method according to claim 3 wherein said e-mail further includes a URL address of a second party which, upon placing of an order using said order section, will be used to send said order automatically to said second party, said URL address being different from the URL address of said first party.

6. (original) A method according to claim 5 wherein said second party will fulfill said order placed by said customer.

7. (original) A method according to claim 6 wherein a portion of the money paid by said customer to said second party is allocated to said first party.

8. (original) A method according to claim 5 wherein a notice is sent to said first party by said second party when said order is placed with said second party.

9. (original) A method according to claim 7 wherein said portion of the money paid to said second party is forwarded to said first party upon or after receipt of payment by said customer to said second party.

10. (original) A method according to claim 1 wherein said e-mail includes the ability for the customer to send an e-mail to a third party for

allowing access to said images at said server and for placement of an order by said third party.

11. (original) A method according to claim 10 wherein said customer further permits said third party to provide additional data to said images.

12. (original) A method according to claim 1 wherein said server allows said third party to provide data to said dynamic data.

13. (original) A method according to claim 1 wherein said communication network comprises the Internet.

14. (original) A method for ordering goods and/or services over a communication network, comprising:

providing a server of a first party for sending e-mail to a receiving site of a customer over said communication network, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said static text and/or graphics containing an order section for ordering of goods and/or services with respect to said dynamic data.

15. (original) A method according to claim 14 wherein said server having a low-resolution digital image file of at least one said digital image, wherein said dynamic data comprises said low-resolution digital image file.

16. (original) A method according to claim 14 wherein said static text and/or graphics comprises an order form for placement of an order for goods and/or services with respect to said image.

17. (original) A method according to claim 14 wherein said static text and/or graphics includes at least one location for receiving said digital image upon opening of said e-mail.

18. (original) A method according to claim 16 wherein said e-mail further includes a URL address of a second party which, upon placing of an order using said order section, will be used to send said order automatically to said second party, said URL address being different from the URL address of said first party.

19. (original) A method according to claim 18 wherein said second party will fulfill said order placed by said customer.

20. (original) A method according to claim 19 wherein a portion of the money paid by said customer to said second party is allocated to said first party.

21. (original) A method according to claim 18 wherein a notice is send to said first party by said second party when said order is placed with said second party.

22. (original) A method according to claim 20 wherein said portion of the money paid to said second party is forwarded to said first party upon or after receipt of payment by said customer to said second party.

23. (original) A method according to claim 14 wherein said e-mail includes the ability for the customer to send an e-mail to a third party for allowing access to said images at said server and for placement of an order by said third party.

24. (original) A method according to claim 23 wherein said customer further permits said third party to provide additional data to said images.

25. (original) A method according to claim 14 wherein said server allows said third party to provide data to said dynamic data.

26. (original) A method according to claim 14 wherein said communication network comprises the Internet.

27. (original) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a computer causes the computer to perform the following steps:

 sending an e-mail from a server at a first location to a remote receiving site of a customer over a communication network, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said dynamic data comprising at least digital data files containing digital images.

28. (original) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a computer causes the computer to perform the following steps:

 sending an e-mail from a server at a first location to a remote receiving site of a customer over a communication network, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said static text and/or graphics containing an order section for ordering of goods and/or services with respect to said dynamic data.

29. (original) A system for ordering goods and/or services with respect to digital images over a communication network using e-mail, comprising:

a server for sending e-mail to a computer of a customer at a remote site from said server, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said static text and/or graphics containing an order section for ordering of goods and/or services with respect to said dynamic data

a fulfillment provider for filling of said order, said e-mail having information for allowing the automatic forwarding of said order to said fulfillment provider.

30. (original) A system for ordering goods and/or services with respect to digital images over a communication network using e-mail, comprising:

a retailer for receiving an image product having at least one image from a customer for the providing of goods and/or service for said customer;

a server for sending e-mail to a computer of a customer at a remote site from said server, said e-mail having a static section for containing static text and/or graphics and a dynamic area/section for containing dynamic data, said dynamic data comprising at least one digital image file of an image obtained from said image product, said dynamic data is automatically forwarded to said receiving site only upon opening of said e-mail at said receiving site, said static text and/or graphics containing an order section for ordering of said goods and/or services with respect to said dynamic data.

a fulfillment provider for filling of said order, said e-mail having information for allowing the automatic forwarding of said order to said fulfillment provider.

31. (original) A system according to claim 30 wherein said server is remote from said retailer.

32. (original) A system according to claim 30 wherein said fulfillment provider is remote from said retailer.

33. (original) A system according to claim 32 wherein said fulfillment provider is remote from said server.

34. (original) A system according to claim 32 wherein said fulfillment provider pays said retailer a portion of payment received from said customer for said order.

35. (original) A system according to claim 32 wherein said fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which of said plurality retailers forwards which of said orders to said fulfillment provider.

36. (original) A system according to claim 35 for keeping track when said customer pays said fulfillment provider and forwarding a portion of

payment received from said customer to said retailer that sent said order to said fulfillment provider.